

Remarks

Entry of the above amendments is respectfully requested. Claims 1, 3, 5, 7, 9, 11, 15, 21, 26, 28, 32, 46, and 47 have been amended. Claim 14 has been canceled. Favorable reconsideration and allowance of this application is respectfully requested in light of the foregoing amendments and the remarks that follow.

1. Objections to the Priority

In the Office Action, the Examiner has objected to the applicant's claim of priority under 35 U.S.C. § 120. Applicant had previously claimed in error that the presently pending application was a continuation application of U.S. Serial No. 09/855,960 now U.S. Patent No. 6,530,268. The present application is in fact a continuation-in-part of the above referenced application. Applicant has amended the specification to properly indicate that the present application is a continuation-in-part of U.S. Serial No. 09/855,960, filed May 15, 2001, now U.S. Patent No. 6,530,268, which is a continuation-in-part of U.S. Serial No. 09/803,268, filed March 9, 2001. Thus, pending approval of the proposed amendments, applicant respectfully requests that the Examiner withdraw the objection to applicant's claim of priority.

2. Objection to the Drawing Figures

In the Office Action, the Examiner has objected to the drawings as including certain reference characters not mentioned in the disclosure. More specifically, the Examiner stated that reference numerals 10, 11, 128, 154 and 156 do not appear within the written disclosure.

With this response, applicant has made minor amendments to the specification to correct the deficiencies highlighted by the Examiner. Applicant has amended the specification by replacing the paragraphs beginning on page 1, line 15 and page 2 line 12 to appropriately label reference numerals 10 and 11 as "atomic force microscopes" consistent with the drawings. Applicant has amended the specification by replacing the paragraph beginning on page 10, line 25 to appropriately label reference numeral 128 as a "circular collar" as referred to in the rest of the application. Applicant has amended the specification by replacing the paragraph beginning on

page 11, line 22 to appropriately label reference numerals 154 and 156 as “vertical links” consistent with the drawings.

Applicant has further amended the specification by replacing the paragraph beginning on page 9, line 16 to appropriately label the reference numeral 104 as a “probe assembly” as referred to in the rest of the application. Applicant has amended the specification by replacing the paragraph beginning on page 13, line 28 to appropriately label reference numeral 102 as the “support.”

In the Office Action, the Examiner has objected to the drawings not showing every feature of the invention specified in the claims. More specifically, the Examiner stated that mounting a light source to an actuator and a flexible disc as a movement isolating device are not shown in the drawing figures and must added to the figures or be canceled from the claims. The Examiner has also objected to Figure 6 as not showing reference numeral 134 as suggested.

Initially, in response to the Examiner’s comments regarding the use of a flexible disc as a movement isolating device as recited in claim 33, applicant calls the Examiner’s attention to application U.S. Serial No. 09/855,960 now U.S. Patent No. 6,530,268 of which the presently pending application is a continuation-in-part. Figure 8A of U.S. Pat. No. 6,530,268 clearly illustrates one embodiment of a flexible disc labeled by reference numeral 310, as claimed in the present case. Because this application has expressly incorporated by reference the disclosure of U.S. Pat. No. 6,530,268, in Applicant’s opinion, this feature has been adequately shown.

With this response, applicant has submitted proposed corrected drawing Figures 5 and 6 in which Figure 5 has been amended to illustrate the light source optionally coupled to the actuator (in phantom), as defined in now amended claim 23, and Figure 6 has been amended to add the reference numeral 134 to the flexible bar illustrated therein, and also delete a spurious “arrow” in the Figure. Applicant has also amended the specification (page 14, line 18) to provide a brief description of the mounted light source as an alternative using a generic mounting arrangement (e.g., a bracket, an adhesive, etc.) such as any known by one skilled in the art. As the amendments to Figures 5 and 6 make only minor additions to these figures, and these features were previously described in the specification, no new matter has been added. Thus, pending

approval of the proposed drawing corrections, applicant respectfully requests that the Examiner withdraw the objection to the drawing figures.

3. Objection to the Specification

In the Office Action, the Examiner has objected to the specification as including several informalities including the use of the term “multi-bar.” With this response, applicant has amended the specification by replacing the paragraph beginning at page 5, line 23 to change the term “multi-bar” to “multiple bar” as suggested by the Examiner. The Examiner also objected to applicant’s inconsistent use of the terms “Figures”, “figures”, “Figure” and “figure.” With this response, applicant has amended the specification by replacing the paragraph beginning at page 9, line 29 to change the term “figure” to “Figure” such that all uses of the term “Figure/s” are consistent.

In the Office Action, the Examiner has objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. Specifically, the Examiner stated that the application fails to provide proper antecedent basis for the use of a flexible disc as a movement isolating device as recited in claim 33. As noted above, this subject matter was previously disclosed and illustrated in application U.S. Serial No. 09/855,960 now U.S. Patent No. 6,530,268 of which the presently pending application is a continuation-in-part. Because the subject matter of that application is expressly incorporated by reference, Applicant notes that proper antecedent basis is present, and an indication to that effect is respectfully requested.

4. Claim Objections

In the Office Action, the Examiner has objected to claims 1-10, 26, 28, and 32 as including minor informalities.

With this response, applicant has amended claims 1, 3, 5, 7, 9, 23, 26, 28 and 32 as suggested by the Examiner. Thus, applicant respectfully requests that the Examiner withdraw the objection to claims 1-10, 23, 26, 28, and 32.

5. Allowable Subject Matter

Applicant appreciates the Examiner's early indication of allowable claims. In particular, the Examiner has indicated that claims 25, 27, 29-31 and 33-45 are allowed. The Examiner noted that claims 1-10, 26, 28, and 32 are objected to, but would be allowable if corrected in accordance with the Examiner's suggestions. As noted above claims 1, 3, 5, 7, 9, 26, 28 and 32 have been amended as suggested by the Examiner. As such, claim 1-10, 26, 28 and 32 are believed to be in condition for formal allowance, and the same is respectfully requested. The Examiner further indicated that claims 15-20, 22 and 24 define allowable subject matter and would be allowed if amended to include the limitations of the rejected base claims. In response, Applicant has re-written claim 15 in independent form. As such, claim 15 as well as claims 16-24 dependent therefrom, are believed to be in condition for formal allowance, and the same is respectfully requested.

6. Claim Rejections Based on Prior Art

a. Rejections of claims 11, 14, 21, 23, and 46-48 Under §102(b)

The rejection of claims 11, 14, 21, 23 and 46-48 under 35 U.S.C. §102(b) as being anticipated by Marshall U.S. Patent No. 5,196,713 ('713 patent) is respectfully traversed, because, inter alia, independent claims 11, 15, 46 and 47, as amended, from which the remaining claims in this rejection depend, define subject matter not disclosed in the '713 patent

Specifically, claim 15 was indicated as containing allowable subject matter and has been amended accordingly. Claims 21 and 23, as amended, are ultimately dependent on claim 15 and in applicant's opinion, therefore allowable.

Claim 11, as amended in this response requires a multiple bar linkage that facilitates moving the sample holder substantially only in an intended direction of motion of the actuator. Claim 46 requires a reference structure that moves in the direction generally perpendicular to the longitudinal axis of the actuator. Claim 47, likewise, requires a sample coupled to the actuator via a multiple bar linkage so that movement of the actuator in the direction when the actuator is excited to move in a direction coincident with the longitudinal axis of the actuator is substantially

decoupled from the sample .

As inferred by the allowed subject matter, the '713 patent does not disclose these features. Therefore, because the '713 patent does not show these features, in applicant's opinion, claims 11, 46, and 47 are allowable.

Dependent claim 48 is also believed to be condition for allowance by incorporating by reference the limitations of claim 47, and for defining additional features of the invention, which, when considered in combination with claim 47, are not anticipated by the prior art relied upon in the rejection.

Further, claim 14 has been canceled with this response and therefore the rejection of claim 14 is considered moot.

In light of the forgoing, Applicant respectfully requests the withdrawal of the rejection of claims 11, 21, 23, and 46-48.

4. Rejections Under 35 U.S.C. §103(a)

The rejection of claims 12 and 13 under 35 U.S.C. §103(a) as being unpatentable over the '713 patent and in further view of U.S. Patent No. 5,298,975 ('975 patent) is respectfully traversed, because, inter alia, combining the references will not produce the claimed invention.

As noted above, in this response, claim 11 has been amended in a manner consistent with the allowed subject matter. Claim 11, as amended in this response requires a multiple bar linkage that facilitates moving the sample holder substantially only in an intended direction of motion of the actuator.

As indicated by the allowed subject matter, neither the '713 patent nor the '975 patent discloses this limitation. Claims 12 and 13 depend from independent claim 11 and each consequently includes all the limitations found in claim 11.

As a result, because the '713 patent and the '975 patent fail to disclose or suggest a combination of each of the elements of claim 11, from which claim 12 and claim 13 depend, these prior art references also fail to disclose or suggest the combination of the elements of

claims 12 and 13. In light of the foregoing, withdrawal of the rejection of claims 12 and 13 is respectfully requested.

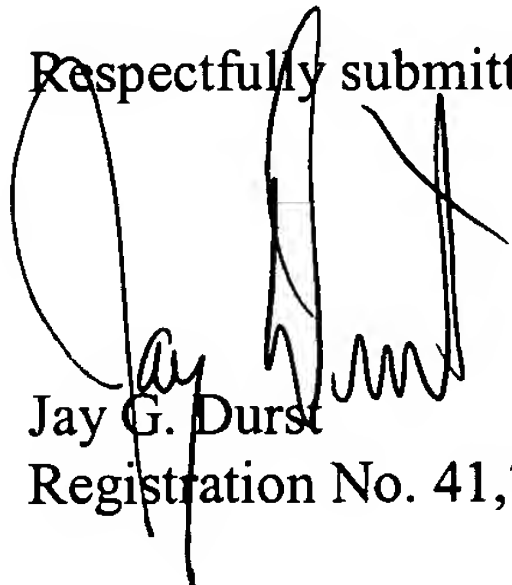
Conclusion

It is submitted that claims 1-13 and 15-48 are in compliance with 35 U.S. C. §§102 and 103 and each define patentable subject matter. A Notice of Allowance is therefore respectfully requested.

No fees are believed to be payable with this communication. Nevertheless, should the Examiner consider any other fees to be payable in conjunction with this or any future communication, the Director is authorized to direct payment of such fees, or credit any overpayment to Deposit Account No. 50-1170.

Should any further matters remain, the Examiner is invited to contact the undersigned by telephone if it would help expedite the prosecution and allowance of this application.

Respectfully submitted,


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Amendments to the Drawings:

Attachment: Replacement sheet labeled 5 and 6.